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Office-Supreme Court, U. S.
SEP 20
CHARLES ELMORE CROPLEY

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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SUPPLEMENTARY STATEMENT.

OF THE TWO PATENTS involved in this suit, the first, Youngs, No. 2,213,113, August 27, 1940, the "Visual Test Patent," was held invalid for lack of novelty (R. 419), and the second, Youngs and Ballantine, No. 2,244,591, June 3, 1941, the "Electrical Test Patent", was held invalid for anticipation (R. 422).

Petitioner charges (Pet. 3) that "respondent did no research and simply appropriated the teachings of petitioner's patents". But whether respondent did any research or not—actually it did plenty—is beside the point; respondent is not charged with appropriating trade-secrets or with any other form of unfair competition. As for appropriating the teachings of petitioner's patent, that depends upon whether those patents disclose and claim any novel contributions to the art subject to appropriation, and the charge, therefore, begs the question.

This is the first and only time these patents have been litigated so that the case presents no question of conflict as to either validity or infringement. Nor does it present any other question requiring this Court's answer.

SUMMARY OF ARGUMENT.

The first patent in suit, the Visual Test Patent, purports to cover a method of testing thin rubber articles for holes, but the method as claimed consists only of snugly mounting an article to be tested on a form and immersing it in water, whereupon the water, entering any sizeable hole, forms a visible dark spot around it. Although Youngs, observing this old natural phenomenon, may have understood its significance, the Court of Appeals held that the mere observation of a natural process lacked patentable

novelty. At the trial, petitioner's expert conceded that it had been known for at least 40 years to test rubber articles, such as rubber gloves, by means of an electrical test in which the rubber article was located between metal and water, exactly as disclosed in the Visual Test Patent. The formation of dark spots was inevitable. The Court of Appeals held that seeing the inevitable was not patentable, and that the Visual Test Patent could not be used to prevent the art from using the old electrical test.

The second patent in suit, the Electrical Test Patent, discloses and claims apparatus for testing thin rubber articles for holes by means of electric current leakage. A test article is stretched upon a metal form, immersed in a bath of water or other conductive liquid, exactly as in the visual test, and an attempt made to pass an electric current from the form to the bath through the rubber article. If the article is sound no current will flow because rubber is an insulator; if the article has a hole, contact is made between the form and the bath and electric leakage current flows, indicating by suitable means the presence of the hole. But such apparatus was not new, as the record showed, and the Court of Appeals held the claims in suit invalid for anticipation.

The Court of Appeals, disposing of one patent for lack of novelty and the other for anticipation had no need to apply the exacting standard of invention, the importance of which this Court has latterly reiterated.

In reversing the District Court the Court of Appeals relied upon undisputed evidence and so did not violate the provisions of Rule 52 (a) F.R.C.P.

Neither patent in suit had been previously adjudicated so there is no conflict. Nor does the case present any other question requiring this Court's attention.

ARGUMENT.

THE VISUAL TEST PATENT. YOUNGS, NO. 2,213,113 (R. 228).

This patent relates to a method of visually detecting the presence of holes in thin rubber articles. The patentee says:

> "The present invention is based essentially upon the discovery that by stretching prophylactic articles of thin rubber over a mandrel or other supporting form and then immersing the same in a bath of liquid, the said liquid will pass through even the most minute hole or perforation in the article and spread over the interior surface thereof between said article and mandrel producing a comparatively dark spot or area which is readily perceptible to the human eye" (p. 1, col. 1, lines 40-49).

This describes a natural phenomenon "which is readily perceptible to the human eye". Youngs, of course, did not invent the phenomenon; he simply observed and understood it. The phenomenon, manifesting itself in accordance with natural laws, manifests itself whenever conditions are propitious whether or not a perceptive human eye be within eyeshot. Petitioner's expert conceded that a prophylactic on a metal form is a sheet of insulating material and that it had been known for more than 40 years to test for holes in insulating material by interposing such material between the metal and the water, and attempting to pass an electric current between the metal and the water through any holes in the insulation (R. 112-113). Petitioner's expert further admitted that prior to 1937 (the patent was filed October 10, 1939) rubber gloves had been tested by mounting them snugly on metal forms, dipping them into water, attempting to pass an electric current through the gloves, and measuring any

current passed (R. 137, 139, 154). Conditions being propitious for the dark spot phenomenon it must surely have manifested itself during those old tests. So it comes to this: was Youngs entitled to a patent for observing this phenomenon? The Court of Appeals thought not—and properly so.

Conceivably Youngs might have utilized the dark spot phenomenon in some patentable way. Conceivably the machine which he devised for this purpose might have had patentable features, but if so he did not claim them. He claimed merely the method of producing the inevitable dark spot: mounting the test article on a form and dunking it. But this, without more, was not new. As for mere observation of a natural phenomenon, the Court of Appeals said (R. 418):

> "a method patent in general must ultimately come back to some law of nature or natural phenomenon; many a patent must rely on and make use of the law of gravity, the law of friction, the law of conservation of energy. But in general these will be found embodied in some process of a new or novel nature leading to the planned end. The defendant is on solid ground in urging that mere observation of a natural process can hardly be considered to possess such novelty."

Whereupon the Court held the patent invalid "for lack of novelty" (R. 419).

THE ELECTRICAL TEST PATENT.

YOUNGS AND BALLANTINE, NO. 2,244,591 (R. 232).

The nature of the invention of this patent is stated in the opening sentence of the specification.

> "This invention relates to new and useful improvements in apparatus for testing thin rubber articles and more particularly for testing such articles for imperfections, such as holes and perforations therein."

The presence of holes is indicated electrically rather than visually as in the Visual Test Patent. Thus, beginning on line 69, column 2, page 2 of the patent, the patentees state:

> "This detection of imperfections in the articles through the medium of an electric current involves the principle of current leakage through the rubber article."

The electrical test of this patent is fundamentally a very simple one. The rubber article to be tested is mounted on a metal form or mandrel, which stretches it slightly to eliminate wrinkles, as in the visual test, and immersed in a tank containing an electrically conductive bath which is connected in series with an indicator, such as an electric lamp, a source of current, and a test electrode. As a preliminary step the form engages a grounded electrode (unclaimed) to discharge any static charge which may be accidentally present. It is subsequently brought into contact with the test electrode. If the article is without holes no current will flow, because the rubber acts as an insulator, and the lamp will not light; but if there *is* a hole the liquid of the bath will flow through it and make contact with the form, whereupon a leakage current will flow, the lamp will light, thus indicating that an imperfect article is on test, and a removal device (unclaimed) may be readied for action. In practice, however, when low voltage test currents are used for safety's sake, the current flowing through a small hole in an imperfect article is too small to light a lamp, or swing the needle of a milliammeter, or trigger a removal apparatus, and so it must be amplified. But there was nothing new in amplification or in the amplifying means used by the patentee, as plaintiff's expert conceded (R. 113, 123, 137).

Neither was Youngs and Ballantine's leakage current test for detecting the presence of holes in rubber articles new, as petitioner's expert admitted. Furthermore, it had

been described, applied to rubber gloves, in an article published in the Electrical World for March 12, 1927 (R. 278). Discussing this article the Court of Appeals wrote (R. 422):

> "The device there pictured and described showed a grounded tank of water from which a lead was taken through a power source to an indicator. From the other side of the indicator was a lead to a horizontal metal rod to which were attached metal chains allowed to hang vertically. The lower ends of these chains were dropped into the upper and open ends of the gloves, which were themselves filled with water. When the voltage was raised to the required test level, current would flow through the indicator if the article was unsound, but not otherwise. Here, then, was a device in use for testing rubber goods by using electrical current conducted through water; we see no substantial difference between the water as the conductor on both sides of the article as in this device and the water and metal of the patent under consideration here. The fact that one was a high-voltage test for imperfections, rather than holes, in the glove, while the other was one of low voltage for holes, seems a difference in degree, and not of kind. We think therefore that the 'Electrical World' article must be considered a printed anticipation of the plaintiff's device, . . ."

This ought to put an end to the matter; but before leaving this patent we must consider briefly the theory of the temporary condenser by which petitioner sets such store. Petitioner, describing the electrical test, writes (Pet. 4):

> "The metal form constitutes one electrode, the conductive bath the second electrode and the rubber article on the form is the dielectric of a Temporary Condenser, i. e., a condenser which exists as such for

but a few seconds while the article remains dipped in the bath. Briefly stated, the metal form is brought into contact with a charging electrode which applies a voltage to charge the temporary condenser. Then the metal form passes to a testing electrode which is connected through a conventional electrical or electronic circuit to a relay which gives a response depending on whether or not there has been a loss of charge due to leakage from the temporary condenser, caused by a hole in the article."

And again (Pet. 9):

"The concept of a *temporary condenser* was found to be broadly new. Such temporary condenser is instantly put together for such test. It is made by stretching the rubber article over a metal form which is then dipped into a conductive bath, so that the condenser *exists only during the few seconds* the form remains in the bath. A relay is connected in circuit with that temporary condenser whose response is selective, depending on whether the temporary condenser maintains the electric charge applied thereto (if the article is good), or loses it (if the article is bad)."

Or as petitioner wrote in its brief below:

"The concept of incorporating the prophylactic rubber article as the dielectric of a *temporary* condenser in the testing machine . . . is the very *heart* or *capital idea* of the invention."

There are several flaws in this argument, not the least of which is that it finds no support in the patent. Each of the four claims in suit, Nos. 1, 5, 21 and 25, defines a simple leakage test apparatus and makes no reference to condensers or dielectrics, temporary or otherwise. Now it is

unfortunately true that a sound article, mounted on its form, *does* act as the dielectric of a temporary condenser so that when a form carrying such an article engages the test electrode, current will surge in to charge the condenser and thus give a false signal unless something is done to prevent it. Youngs and Ballantine prevent it by precharging the condenser at a charging electrode so that when the sound article arrives at the test electrode no further charge can surge in and give a false signal. So "the very *heart* or *capital idea* of the invention" turns out to be, ironically, a nuisance to be abated! Furthermore, there is no claim to the precharging step or the apparatus for performing it. The Court of Appeals correctly appraised the situation (R. 420):

> "It will be noted that contact with the first two electrodes [the static discharge electrode and the charging electrode] is essentially a conditioning process to prevent a 'surge' of potential or a false charge which might momentarily disturb the delicate indicator and thus temporarily mislead the operator or even 'trigger' the removal device if that is in use. Contact with the third or 'test' electrode is the important step; that embodies the inventive idea claimed in the patent and in the claims 1, 5, 21 and 25 here in issue. These, after describing the 'electrically conductive element,' i. e., the mandrel, and the 'trough' for immersion of the rubber article stretched on the mandrel, proceed to state the essential invention in language such as this of claim 1: 'electrical means connected to the element and said trough and *operable in response to the presence of a hole in the article,* and means operable by said electrical means for indicating the presence of a hole in said article" (the Court's italics).

Petitioner does not challenge this appraisal. In short, the claims cover a simple current leakage test apparatus, the

essentials of which had been disclosed in the Electrical World article, and were conceded to be old.

It may be noted parenthetically at this point, that any one performing the electrical test of this second patent, which the Court of Appeals found anticipated by the prior art and hence in the public domain, must willy-nilly infringe the claims of the first or Visual Test Patent unless, as the Court suggested (R. 419), one "put on blinders to avoid observation", a *reductio ad absurdum* which in the opinion of the Court, "illustrates the lack of worth of the patent"—the Visual Test Patent.

OTHER DEFENSES.

Not only are the claims in suit invalid for lack of novelty and anticipation, as the Court of Appeals found; it is our position that when properly construed they are not infringed. Furthermore, the claims of the Visual Test Patent are invalid because not directed to a statutory method and, having been granted to Youngs as a sole inventor, are invalid over the previously filed Electrical Test Patent granted to Youngs *and* Ballantine as joint inventors.

THE REASONS RELIED ON BY PETITIONER FOR ALLOWANCE OF THE WRIT.

Of the three reasons stated, the first two (Pet. 6 and 10) have to do with the too exacting standard of invention which, so petitioner avers, the Court below applied, thereby misinterpreting recent decisions of this Court on the point. It seems to us that petitioner has misread the opinion below. The claims in suit were *not* held invalid for lack of invention, whatever views on the quality of invention displayed the Court may have entertained; the Visual Test Patent was held invalid "for lack of novelty", and the Electrical Test Patent for "anticipation".

A patent may disclose and claim a novel thing and yet lack invention, or it may display the quality of original invention and yet, unhappily, lack novelty. In either case the patent is invalid, but for different reasons. The statute, R. S. 4886, prescribes the three imperatives of patentability: invention, novelty, utility, lacking any of which a patent must fall. Here we are concerned with lack of novelty.

As for the third reason (Pet. 11): that the Court of Appeals violated Rule 52 (a) F.R.C.P. by setting aside findings of fact made by the Trial Court that were not clearly erroneous, it is plain from what we have just said that the Appellate Court's findings as to novelty and anticipation were based on undisputed evidence which that Court could appraise as well as the Trial Court, and that in the opinion of the Appellate Court the findings of the Trial Court, based on this evidence, *were*, "clearly erroneous". We respectfully call this Court's attention to the section on Rule 52 (a) in our brief in *Frank B. Killian & Co.* v. *Allied Latex Corp.*, No. 256, filed concurrently herewith.

THERE IS NO GOOD REASON WHY THE WRIT SHOULD BE ALLOWED.

Petitioner concludes (Pet. 15) with a rhetorical question: "Does the Court of Appeals for the Second Circuit correctly apply the standards of invention set by this Court?", and then proceeds to answer it: "We maintain it does not and unless corrected, patents will become a nullity in the Second Circuit". But this horrendous improbability need not concern us here, because the Court of Appeals for the Second Circuit did *not* hold the patents in suit invalid for lack of invention, but for lack of novelty and for anticipation and, therefore, had no need to apply, either correctly *or* incorrectly, the standards of invention set by this Court.

Like the companion Killian case, this is just another patent suit in which the defeated litigant turns to this Court in the hope of obtaining a favorable decision. As the two patents in suit had never been adjudicated before there is no conflict, and the case presents no questions requiring answer by this Court.

THE PETITION FOR A WRIT OF CERTIORARI SHOULD BE DENIED.

Respectfully,

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